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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,209	08/24/2001	Pat Ressler Levitt	00-539-US	3394

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EXAMINER

QIAN, CELINE X

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/939,209

Applicant(s)

LEVITT ET AL.

Examiner

Celine X Qian Ph.D.

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1, 5, 18, 20 and 46.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

Continuation of 2. NOTE: the proposed amendment raises issue that would require new search. Claim 1 is amended to recite "an isolated and substantially purified DNA sequence comprising SEQ ID NO:3...or a fragment of SEQ ID NO:3, wherein said fragment includes at least one of said variant." The claim is now drawn to any DNA sequence that comprises the full length or "a fragment" of SEQ ID NO:3. The claim is previously drawn to a DNA sequence comprises full length SEQ ID NO:3 with the claimed variation, or contiguous portion of SEQ ID NO:3. The "contiguous portion" was interpreted as DNA regions adjacent to 5' or 3' of SEQ ID NO:3. As such, the amendment changes the scope of the claim. Therefore, a new search is required. In addition, such amendment also raises issue of written description. The claimed genus encompasses a large number of nucleic acid sequences of various size and structure/sequence that may be genes of different family. The specification only discloses the gene having the sequence of SEQ ID NO:3 having the claimed variation that is related to schizophrenia. As such, the written description requirement is not met. Thus, the proposed amendment will not be entered.

Continuation of 5. does NOT place the application in condition for allowance because: the proposed amendment raised new issues that would require further consideration and new search as discussed above. The allowable subject matter is a DNA variant of SEQ ID NO:3, wherein said variant is SEQ ID NO:3 comprises at least one variation selected from the group consisting of a T at nucleotide base number 4121 of SEQ ID NO:3; a C at nucleotide base number 4621 of SEQ ID NO:3; a T at nucleotide base number 4970 of SEQ ID NO:3; a C at nucleotide base number 11056 of SEQ ID NO:3; and a T at nucleotide base number 12145 of SEQ ID NO:3, a vector and an host cell comprising said DNA variant.

DAVE TRONG NGUYEN  
PRIMARY EXAMINER

